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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,191	11/21/2001	Stephen J. Padden	HM-69621	4104

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EXAMINER

TRUONG, THANH K

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,191

Applicant(s)

PADDEN, STEPHEN J.

Examiner

Thanh K. Truong

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-11 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-11 and 21-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment received on March 21, 2005.
2. Applicant's cancellation of claims 7 and 12-20 is acknowledged.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 21-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Chiou (4,807,744).

Chiou discloses an apparatus comprising:

a housing (1) having a periphery that includes a bottom wall and a first side wall (figure 1);

a recess (11) extending into the bottom wall and the first sidewall;

a stapler (21) operatively mounted to the recess, and the stapler having a base that is about coplanar with the bottom wall and an actuating member that is releasably secured to the recess.

Chiou further discloses: the stapler has an actuating member attached to the housing (figure 2 shows the stapler is attached to the housing); the stapler has a back end and an open end, with the open end facing outward from a peripheral wall (the recess 11 has the outside wall open, thus the stapler's open end is facing outward from

the peripheral wall), the actuating member being pivotally attached to the base at the back end (figure 2 shows the pivotal end of the stapler is attached to the recess); the recess having a shape that corresponds to the outline of the stapler (figure 2); and the open end of the stapler is about coextensive with the side wall (figures 1 and 2 clearly shows that when the stapler is attached to the recess, its open end is about having the same boundaries with the side wall).

5. Claims 1, 9, 21 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Orozco (5,184,765).

Orozco discloses an apparatus comprising:

a housing (10-11) having a periphery that includes a bottom wall and a first side wall (figures 4 & 5);

a recess (on the left hand side of the housing 10-11 in figure 5) extending into the bottom wall and the first sidewall;

a stapler (20) operatively mounted to the recess (figures 3 & 4), and the stapler having a base that is about coplanar with the bottom wall and an actuating member that is releasably secured to the recess (figures 3 & 4).

Orozco further discloses a hole punch (31, 32, 33) and a holding means for selectively fixing the hole punch in the corner opening (figures 4 & 5).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiou (4,807,744) in view of Padden (6,009,584).

As discussed above in paragraph 7 of this office action, Chiou discloses the claimed invention, but does not expressly disclose the recess for the stapler as recited in claims 2-6 and 8, however, it is well known in the art to create recess in the housing of the multiple-purpose tool holder in such a way that the recess accommodates the shape and size of the tool being inset to the housing. The recess comprises slot, curve portion, flange, tab, etc.

Chiou shows recesses in the housing to accommodate the shape of varieties of tool, such as recess (11) for the stapler, recess (15) for the pen (5), recess (12) for the knife (3), etc.

Padden's disclosure further supports the contention that it is well known in the art to create recess in the housing of the multiple purpose tool holder with varieties of shapes and sizes to accommodate varieties of tool. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Chiou by incorporating the creation of recesses in the housing of the multiple-purpose tool holder to fit different tools as taught by Padden.

As for a hole punch to fit an opening at the corner opening in the tool housing as recited in the claim 9, the examiner takes official notice that it is within the skill of one in the art to provide a hole puncher in the multiple purpose tool holder providing a complete stationery tool set.

Regarding to claim 9, the applicant has not challenged the examiner's taking of Official Notice. Therefore, the position is maintained and the subject matter, per se, of claim 9 is deemed admitted prior art.

8. Claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Chiou (4,807,744) in view of Ng (6,145,994).

As discussed above in paragraph 7 of this office action, Chiou discloses the claimed invention, but does not expressly disclose a lighting means mounted within the housing and oriented for illumination through the aperture, and an activation means to illuminate the lighting.

Ng discloses an apparatus comprising lighting means (30) mounted within the aperture and an activation means (28) to illuminate the lighting, Ng apparatus provides the multiple-purpose tool holder with lighting capability. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Chiou by incorporating the lighting apparatus as taught by Ng providing the multiple-purpose tool holder with lighting capability.

Response to Arguments

Applicant's arguments filed March 21, 2005 have been fully considered but they are not persuasive.

9. In response to the applicant's argument that Chiou's stapler is entirely inoperative and non-accessible to a user, and no part of the stapler forms a wall portion of the housing, the examiner disagrees.

The examiner construes that the stapler is operatively mounted to the recess as claimed, because one can activate the stapler even when it is disposed in the recess. The argument that the stapler is "non-accessible to a user" is irrelevant, because that is not being claimed. Figure 2 clearly shows that the left hand side of the stapler (21) forms a wall portion of the housing (1), and the bottom of the stapler is coplanar with the bottom of the housing.

10. Applicant's arguments with respect to Tsuji (4,753,346) have been considered but are moot in view of the new ground(s) of rejection.

11. In response to the applicant's argument that Padden (6,009,584) does not mention a stapler, therefore it would not obvious to combine with Chiou, the examiner disagrees. Padden is relied upon to show that it is well known in the art to create the recesses in the housing of the multiple-purpose tool holder in such a way that the recesses accommodating the shape and size of the tools being inset to the housing. The recesses comprise slots, curve portions, flanges, tab, etc.

12. In response to applicant's argument that the reference of Ng (6,145,994) shows the light bulb extends outwardly from the periphery of the overall housing, and in

contradistinction, applicant's lighting means is mounted inside its housing and illumination is directed through an aperture. The examiner maintains that Ng's lighting means (30) mounted within the housing and oriented for illumination through the aperture as claimed (figure 9).

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tkt
June 3, 2005.



Stephen F. Gerrity
Primary Examiner

571-272-4460